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09/721,484	11/22/2000	Eva Manolis	11087-010003	2154

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,484

Applicant(s)

MANOLIS ET AL.

Examiner

Mark Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 31-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 USC 121:

- I. Claims 1-9, drawn to account summary with image, classified in class 705, subclass 27.
- II. Claims 10-15, drawn to a message printed on an image, classified in class 358, subclass 1.13.
- III. Claim 16, drawn to editing an address book, classified in class 707, subclass 200.
- IV. Claims 17-30, drawn to a thumbnail upload, classified in class 345, subclass 838.
- V. Claim 31-64, drawn to electronic commerce, classified in class 705, subclass 26.

Inventions I and II are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention II has separate utility such as printing a message on an image. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above the search required for group I is not required for Group II, restriction for examination purposes as indicated is proper.

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Inventions II and III are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention III has separate utility such as editing an address book. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above the search required for group II is not required for Group III, restriction for examination purposes as indicated is proper.

Inventions III and IV are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention II has separate utility such as uploading a thumbnail sketch. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above the search required for group III is not required for Group IV, restriction for examination purposes as indicated is proper.

Inventions IV and V are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention II has separate utility such as electronic commerce. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above the search required for group IV is not required for Group V, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Tran Bao on 12/02/2003 a provisional election was made without traverse to prosecute the invention in Group V claims 31-64. Affirmation of this election must be made by the applicant in reply to this Office action. Claim 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings filed on 11/24/2000 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Objections

Claim 50 is objected to because of the following informalities: "in specified" should be "as specified". Appropriate correction is required.

Claim 51 is objected to because of the following informalities: "concomitant" should be "commitment". Appropriate correction is required.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31,32,34,35,36,37,51 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Dodd (US 6,321,211).

In regards to claim 1, Dodd discloses a method for designating multiple recipients for an image at an on-line print service (FIG 1C, select recipient, .

First the examiner would like to define what is understood to be applicant's envelope. The applicant defines on page 10 line 2 that "An envelope is a virtual storage entity for holding images that are to be printed and delivered to a single destination". Microsoft Computer Dictionary defines a shopping cart as "a file in which an online customer stores information on potential purchases". Therefore the examiner considers the old and well known electronic shopping cart to be synonymous with the applicants envelope (see also col 1, lines 26-44)., the method comprising:

creating a plurality of envelopes and displaying each envelope on a user interface (FIG 1B and 1C);

associating with each envelope an intended recipient to receive images placed in a respective envelope (FIG 1C, card image).

displaying on the user interface one or more images along with the plural envelopes (FIG 1C, card images) ;

selecting an image for distribution to multiple recipients (FIG 1C); and

associating a selected image with two or more envelopes (FIG 1C).

In regards to claim 32, Dodd teaches displaying along with each envelope an identifier associated with the name of a recipient (col 4, lines 8-26, email address).

In regards to claim 33, Dodd teaches selecting items and placing the items in a shopping bag, but does not specifically mention that the shopping bag keeps a running total. It was old and well known in the art to include in shopping carts the use of a running total. It would have been obvious to a person having ordinary skill in the art to include in Dodd keeping a running total, because this would permit the user to keep track of how much they are spending and assure that they do not go over budget, thus improving the customers usability.

Furthermore, Dodd does not specifically mention that the product being placed in the shopping bag is a purchased image. It would have been an obvious matter of design choice to include the purchasing of images using the system of Dodd, because the applicant has not disclosed that limiting the purchasing system of Dodd to only purchasing images solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well selling images.

In regards to claim 34, Dodd teaches displaying a checkbox with each image, the checkbox for designating an image to be included in an order (FIG 1B, item 130).

In regards to claim 35, Dodd teaches wherein the step of associating an image includes placing an instance of the image in each envelope associated with an intended recipient (FIG 1B, a sample pictorial of the product).

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In regards to claim 36, Dodd teaches an add button or link associated with each envelope, the add button, when invoked, operable to add a copy of each selected image to a respective envelope (FIG 1C, change button, and/or Figure 1B, item 130).

In regards to claim 37, Dodd teaches wherein the step of associating includes selecting an add button or link associated with an envelope of an intended recipient (FIG 1B).

In regards to claim 51, Dodd teaches processing all of the envelopes as a single order; and sending an email confirmation to user describing the order concomitant with the processing step (FIG 2A).

In regards to claim 52, Dodd teaches wherein the email confirmation includes a summary of each envelope (col 11, lines 18-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33,38,39,40,53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Official Notice.

In regards to claim 33, Dodd teaches selecting items and placing the items in a shopping bag, but does not specifically mention that the shopping bag keeps a running total. It was old and well known in the art to include in shopping carts the use of a running total. It would have been obvious to a person having ordinary skill in the art to include in Dodd keeping a running total, because this would permit the user to keep track of how much they are spending and assure that they do not go over budget, thus improving the customers usability.

Furthermore, Dodd does not specifically mention that the product being placed in the shopping bag is a purchased image. It would have been an obvious matter of design choice to include the purchasing of images using the system of Dodd, because the applicant has not disclosed that limiting the purchasing system of Dodd to only purchasing images solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well selling images.

In regards to claim 38, Dodd teaches displaying price and quantity data associated with each envelope ((FIG 1B),

Dodd teaches selecting items and placing the items in a shopping bag, but does not specifically mention that the shopping bag keeps a running total or that the items once selected in Figure 1C show a total for the package to be purchased. It was old and

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well known in the art at the time of the invention to include in shopping carts the use of a running total and to give a final price for a selected package of goods or services. It would have been obvious to a person having ordinary skill in the art to include in Dodd keeping a running total and giving a configuration price, because this would permit the user to keep track of how much they were spending and permit the user to know how much the selection will cost.

, and

the quantity data including a count of a number of images included in the respective envelope (FIG 1B, item 135).

In regards to claim 39, Dodd teaches updating the price and the quantity data for a given envelope each time a new image is associated with a given envelope (see response to claim 1 and 38).

In regards to claim 40, Dodd teaches displaying an order total indicative of the price for processing all of the envelopes presented on the user interface. Dodd does not expressly point out that the method of Dodd is adding up multiple shopping carts on display, however the above discussion shows how the method does this for a single shopping cart. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to sum up the total for all the occasions shown in FIG 1C, since it has been held that mere duplication of essential working parts of a method involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

In regards to claim 53, Dodd teaches processing all of the envelopes in a single order; and displaying a status of the order when prompted by the user through the on-line print service (see response to claim 40 and FIG 2E).

In regards to claim 54, Dodd teaches
processing all of the envelopes in a single order;
aggregating summary information for each envelope on a single user interface page accessible by the user through the on-line print service. (see response to claim 40)

Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Sharp (et al. (US 6,263,317).

In regards to claim 41, Dodd teaches making a purchase and a shopping bag, but does not mention that the system includes an order details button that summarized the purchases being made. Sharp teaches an order details button that can be used to present to the user a summary of a plurality of purchases (FIG 13). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd the order details button as taught by Sharp, because this would give the user an opportunity to scan back to the order to decide if the configuration was correct and give another opportunity to reselect or delete from the order items that are not wanted,

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thus improving the shopping experience for the user. It should be noted that this is a common feature used in electronic shopping carts.

In regards to claim 42, Dodd teaches wherein the envelope summary includes a message to be printed on the print (FIG 2A, item 141).

In regards to claim 43, Dodd teaches wherein the envelope summary includes a preview of the print including as ordered including any user-designated effects (FIG 1C).

In regards to claim 44, Dodd teaches changing an order for an intended recipient when reviewing the envelope summary and automatically recalculating the price and quantity data displayed on the user interface for an associated envelope (see response to claim 41).

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd as in view of Spiegel et al (6,629,079).

In regards to claim 45, Dodd teaches ordering a plurality of products to multiple recipients (Claims 1A, 1B and 1C), but does not specifically state that an order button on the user interface along with the envelopes and image selections, the order button operable, when selected, to place an order in accordance with the envelopes specified

on the user interface for plural recipients from a single user interface page. Spiegel teaches an order button on the user interface along with the envelopes and image selections, the order button operable, when selected, to place an order in accordance with the envelopes specified on the user interface for plural recipients from a single user interface page (FIG 1). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd the web page features as shown in Spiegel, because this would allow the user to complete the action without having to go to additional page, thus improving usability of the system.

Claims 46-50 and 55-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Sharp in view of Spiegel and further in view of Official Notice.

In regards to claim 46, Dodd teaches displaying an order summary in a single summary user interface for plural recipients, the order summary including plural entries, one for each envelope specified in the user interface (see response to claims 40 and 41).

In regards to claim 47, As previously discussed the combination of Dodd/Sharp/Spiegel/Official Notice teaches listing items on a single page and totaling a price, but this combination does not specifically mention that the price includes cost for

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selected shipping expenses. It was old and well known in the art at the time of the invention to add any number of costs to a final shipping invoice, including costs associated with shipping, which can vary considerably on the needed time for delivery (overnight), distance, country, quantity or weight to be shipped. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd/Sharp/Spiegel/Official Notice the further cost of shipping or any other extraneous cost, because these costs may sometimes be more than the part itself, therefore the company could potentially lose money if these costs were not included in the final total to the customer.

In regards to claim 48, Dodd teaches displaying quantity data and price data on the order summary for each envelope (see response to claim 39).

In regards to claim 49, Dodd teaches displaying a pay now button, that when invoked, is operable to process all of the envelopes specified in the order summary (Spiegel, FIG 1).

In regards to claim 50, Dodd teaches processing of the order, however, the combination of Dodd/Sharp/Spiegel/Official Notice does not expressly point out that the method of Dodd is adding up multiple shopping carts on display. The above discussion shows how the method of Dodd processes an order for a single shopping cart. It would have been obvious to a person having ordinary skill in the art at the time the invention

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was made to sum up the total for all the occasions shown in FIG 1C, since it has been held that mere duplication of essential working parts of a method involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

In regards to claims 55 through 64, these claims have similar features of claims 31-54 treated above and are therefore rejected for the reasons stated above, with the exception that claims 55-64 have the additional features of sharing images and later making a purchase based on the received image. Dodd teaches these additional features of sharing an image (FIG 2E and 2F) and also teaches purchasing based on the received image (FIG 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner